

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-28 are pending; Claims 1-6, and 8-20 are amended; and Claims 22-28 are added by the present amendment. Support for the amendments is found in the originally filed claims; page 22, lines 14-17, page 27, lines 3-7, pages 31-32, line 12, and pages 42-43, line 9; and Figures 4 and 15. Therefore, no new matter is added.

In the outstanding Office Action, Claims 1-7 were rejected under 35 U.S.C. §112, second paragraph; Claim 1 was rejected under 35 U.S.C. §102(e) as unpatentable over U.S. Patent No. 6,564,253 to Stebbings; Claims 2-5, 7, 8-13, 15-19 and 21 were rejected under 35 U.S.C. §103(a) as unpatentable over Stebbings in view of U.S. Patent No. 5,883,954 to Ronning and further in view of U.S. Patent No. 6,925,448 to Stefik et al. (hereinafter, "Stefik"); Claims 6, 14, and 20 were rejected under 35 U.S.C. §103(a) as unpatentable over Stebbings, Ronning, Stefik and further in view of U.S. Patent No. 6,319,125 to Acres.

Amendments are made to the specification to correct minor informalities. Thus, no new matter is added.

Rejection Under 35 U.S.C. §112, Second Paragraph

In reply to the rejection under 35 U.S.C. § 112, second paragraph, Claim 1 is amended to recite an "information processing apparatus." Therefore, Applicants respectfully submit that the "apparatus" in Claim 1, line 3 has proper antecedent basis. Applicants respectfully request that the rejection of Claims 1-7 under 35 U.S.C. § 112, second paragraph be withdrawn.

Rejection Under 35 U.S.C. §102(e)

The outstanding Official Action rejected Claim 1 under 35 U.S.C. §102(e). Applicants respectfully traverse the rejection.

Claim 1 is amended to recite that the number of possible checkouts “represents a number that is incremented by one when the content is checked back into the apparatus”

Stebbings is directed to a system for encoding original recordings with an authorization system, and preventing unauthorized activity of proprietary data.¹ The system in Stebbings provides different levels of authorization which allows a user to listen to the content, or control the number of copies a user can make of a musical recording.² For example, an authorized user may be allowed to make a copy once, two times, or three times to an external recording medium such as a CD or DVD.³

Claim 1 is distinguishable over Stebbings, as the applied reference fails to disclose displaying a number of possible of checkouts that *represents a number that is incremented by one when the content is checked back into the apparatus*. Stebbings merely describes that a level of authorization dictates the number of copies a user may make of a digital recording.⁴ A number of copies does not *represents a number that is incremented by one when the content is checked back into the apparatus*, because Stebbings neither discloses nor suggests that once a copy is made to a CD or a DVD, the copy is *checked back into* the system.

Additionally, the Official Action asserts that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function where “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus.”⁵ Applicants respectfully submit that Claim 1 does not recite any “intended use,” but instead includes structural features recited functionally, in accordance with well settled case law. For example, while the features of an

¹ See Stebbings at column 3, lines 34-38.

² See Stebbings at column 10, lines 34-38.

³ See Stebbings at column 10, lines 42-45.

⁴ See Stebbings at column 10, lines 31-45.

⁵ See Official Action dated October 3, 2006 at pages 3-4 (quoting Ex Parte Masham, 2 USPQ.2d 1657 (Bd. Pat. App. & Inter. 1987)).

apparatus may be recited either structurally *or functionally*, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function.⁶

As Claim 1 recites a title display means and a number of checkouts display means, Claim 1 describes the structure functionally. Applicants respectfully submit that the display device 83 of Stebbing cannot be considered a “*title display means*” nor the “*number of checkouts display means*” as recited in Claim 1 as Stebbing fails to disclose or suggest that the display device 83 displays the title, and the number of possible checkouts representing a number that is incremented by one when the content is checked back into the apparatus.

Therefore, Applicants respectfully submit that Stebbing fails to disclose all the features of Claim 1. Applicants respectfully request that the rejection of Claim 1 under 35 U.S.C. §102(e) be withdrawn.

Rejections Under 35 U.S.C. §103(a)

The Official Action rejected Claims 2-5, 7, 8-13, 15-19, and 21 under 35 U.S.C. §103(a) as unpatentable over Stebbing in view of Ronning, and further in view of Stefik.

Ronning describes a user interface that displays programs that a user may sample, and the number of samples remaining, which indicates the number of times a program may be sampled.⁷ The number of samples remaining in Ronning cannot be considered to *represent a number that is incremented by one when the content is checked back into the system* because Ronning neither discloses nor suggests that a program is checked back into the system when it is sampled.

Stefik describes a repository that loans digital content to a user.⁸ The digital content may be associated with a Loan-Period indicating the maximum number of time-units that a document

⁶ In re Schreiber, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997) (emphasis added); see also MPEP § 2114.

⁷ See Ronning at column 5, lines 23-36, and Figure 3.

⁸ See Stefik at column 3, lines 61-64, and Table 1.

can be loaned out.⁹ When the digital content is loaned out, the digital content may be used for a period of time before the right to use the content expires.¹⁰ The Loan-Period in Stefik cannot be considered *represent a number that is incremented by one when the content is checked back into the system* because Stefik neither discloses nor suggests that the digital content is checked back into the repository when the content is loaned out.

As outlined above, Stebbings does not disclose all the elements of amended Claim 1, which Claims 2-5, 7, 8-13, 15-19, and 21 depend directly therefrom, or from claims reciting limitations analogous to Claim 1. As Ronning and Stefik do not remedy the deficiency, as discussed above, Applicants respectfully submit that a *prima facie* case of obviousness has not been presented.

Accordingly, Applicants respectfully request that the rejection of Claims 2-5, 7, 8-13, 15-19, and 21 under 35 U.S.C. §103 be withdrawn.

The Official Action has rejected Claims 6, 14, and 20 under 35 U.S.C. §103(a) over Stebbings, Ronning, Stefik, and further in view of Acres. Applicants respectfully traverse the rejection.

Acres describes a bonus gaming system that alerts the user of the system with a sound when a displayed bonus has been decremented to less than one credit.¹¹ Acres neither discloses nor suggests displaying a number of possible checkouts, where the number of possible checkouts represents a number that is incremented by one when content is checked back into the apparatus.

As outlined above, Stebbings, Ronning, and Stefik do not disclose all of the elements of amended Claim 1, which Claims 6, 14, and 20 depend directly therefrom, or from claims reciting limitations analogous to Claim 1. As Acres does not remedy the deficiency, as

⁹ See Stefik at Table 1.

¹⁰ See Stefik at column 10, lines 6-16.

¹¹ See Acres at column 11, lines 44-57.

discussed above, Applicants respectfully submit that a *prima facie* case of obviousness has not been presented.

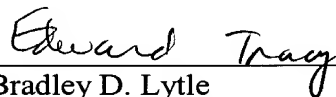
Accordingly, Applicants respectfully request that the rejection of Claims 6, 14, and 20 under 35 U.S.C. §103 be withdrawn.

New Claims 22-28 recite similar subject matter to Claims 1-7, respectively, with the amended feature, without invoking 35 U.S.C. §112, sixth paragraph. Support for the new claims may be found in the originally filed claims; page 22, lines 14-17, page 27, lines 3-7, pages 31-32, line 12, and pages 42-43, line 9; and Figures 4 and 15. Therefore, no new matter is added. As Claim 22 recites similar features as amended Claim 1, Applicants respectfully submit that Claims 22, and claims depending therefrom, are patentable for at least the reasons stated for the patentability of Claim 1.

Consequently, in view of the present response, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. An notice of allowance for Claims 1-28 is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 03/06)
SP/rac

Edward W. Tracy, Jr.
Registration No. 47,998

I:\ATTY\SP\27\S\275729US\275729US-AM.DOC